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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/099,786

03/15/2002

Steven M. Goetz

11738.00058

4876

22907

7590

03/08/2005

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

WONG, ALBERT KANG

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/099,786	GOETZ ET AL.	
	Examiner	Art Unit	
	Albert K Wong	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/02, 2/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. This Office action is in response to the application filed March 15, 2002. Claims 1-11 are pending. It is suggested that applicant amend the specification to include the application number which is missing from the referenced applications. The formal drawings submitted April 4, 2003 have been approved by the Examiner.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ryan 5,350,411.

Regarding claim 1, Ryan teaches an implantable telemetry system where the medical device is programmed with a variety of communication protocols. One of the protocols is selected. The process of selecting the protocol involves the transmission of a software command that is used to load and to install the driver. After the telemetry device is operable, communication is initiated using the protocol. Although Ryan does not explicitly state the loading of a protocol driver, it is conventional in computer systems that peripherals, i.e. printers, modems etc. that communicate with a central processor require a software driver to enable communications. It would have been obvious to load and to install such a software component to enable communications.

Regarding claim 2, it would have been obvious to identify and to compare the existing protocol before switching to a different protocol to avoid unnecessary changes.

Regarding claim 3, it would have been obvious to check to see if a programming function is possible before engaging in the process to prevent damaging the system from improper installation of software.

Regarding claim 4, protocol is merely software. It is conventional to uninstall an existing program before installing a new one to avoid conflicts.

Regarding claim 5, Ryan uses a PLA that is a computer-executable medium.

Regarding claim 6, the telemetry unit is shown in figure 1. The host unit is mentioned but not shown. Ryan teaches the host unit may program the telemetry unit. Ryan also teaches that the telemetry unit can transmit using a variety of communications protocols. It would have been obvious that the host unit includes some means equivalent to the claimed base module to select a telemetry protocol. The sending of commands to select the protocol is considered the protocol driver.

Regarding claims 7-9, it is conventional to use various programming devices to affect the telemetry module. These include physician programmers for monitoring, patient programmers for infusion control, or general-purpose computers for flexible controls. The use of known programmers to affect implants would have been obvious since these are conventional means for controlling implants.

Regarding claim 10, it would have been obvious to use personal or laptop computers because they are inexpensive devices. The use of a hand-held device provides the advantage of portability.

Regarding claim 11, Ryan teaches that the host device is similar to the telemetry unit so that uplink and downlink telemetry is possible. It would have been obvious that the host unit

have the same telemetry protocol and thus, protocol driver to enable communication. Further, Ryan teaches that communication is via RF which would include an antenna.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should consider all of the cited art, even those not applied, since they are considered highly pertinent to the claimed invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 571-272-3057. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Albert K. Wong
February 25, 2005